

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Final Official Action, the Examiner argued that the Information Disclosure Statement (IDS) filed on August 30, 2006 fails to comply with 37 C.F.R. § 1.98(a)(2). In the Advisory Action, the Examiner requests (2) that the citations in the disclosure be included in an IDS and (2) copies of the previously cited references be provided.

In response, an IDS is submitted herewith citing the references mentioned in the specification and submitting copies of the references previously cited.

In view of the above, the Examiner is respectfully requested to make such references of record in the present application and to consider the same.

In the Final Official Action, the Examiner objected to claims 17 and 20. With regard to claim 17, the Examiner argued that the same does not depend from any other claim. In the Response filed under 37 CFR 1.116 on June 2, 2009, claim 17 was amended to depend from claim 29. With regard to claim 20, the Examiner argued that the same depends from claim 15, which was canceled. In the Response filed under 37 CFR 1.116 on June 2, 2009, claim 20 was amended to depend from claim 29.

In the Advisory Action, the Examiner did not address whether such amendments overcome the objections to claims 17 and 20. Thus, it is respectfully requested that the objection to claims 17 and 20 be withdrawn.

In the Final Official Action, the Examiner rejected claims 16-26 and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0081329 to Tsai (hereinafter "Tsai") in view of U.S. Patent No. 4,821,369 to Daniels (hereinafter "Daniels"). Additionally, the Examiner rejected claims 27 and 28 under 35 U.S.C.

§ 103(a) as being unpatentable over Tsai and Daniels and further in view of U.S. Patent No. 4,667,366 to Melara (hereinafter “Melara”).

In response, Applicants respectfully traversed the Examiner’s rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below.

In the Final Official Action, the Examiner argued that Tsai does not disclose the means for axially and rotatably locking the tubular element. However, the Examiner argued that “it would have been an obvious design choice to utilize annular protrusions, annular ridges, two-semi-cylindrical portions and flat portions to lock the tubular element and seat, as Applicant has not disclosed that it solves any stated problem of the prior art.”

In the Response under 37 CFR 1.116 submitted on June 2, 2009, Applicants first argued the courts (In re Ruff, 256 F.2d 590 (CCPA 1958)) have long held that in order for the Examiner to assert that a modification is a design choice, the Examiner first must establish that there are two design choices and that the choices are known functional or mechanical equivalents (emphasis added). Thus, Applicant concluded that the Examiner failed to establish either. Specifically, the Tsai reference does not even contemplate the use of a tubular element, let alone the need to lock it both axially and rotatably with regard to the seat (which Tsai also does not disclose). Thus, the references do not disclose a known related structure or even the need for a related structure that is functionally equivalent or is an alternative design choice. Additionally, one of ordinary skill in the art would not recognize, at the time of the invention, that the supporting body/tubular element with features for locking the tubular element relative to the supporting body (and through seat thereon) axially and rotatably and the one-piece design of Tsai were known functional equivalents or that they were alternative design choices at least for the reasons provided above.

Secondly, the Applicant argued that the use of the two-piece supporting body/tubular element recited in claim 29 over the one-piece support of Tsai results at least in the advantages of allowing movement of the tubular element (e.g., 6) coaxially into the seat (5) without escaping from it, thereby not requiring any additional retaining elements for locking the tubular element either axially or for rotation.

Thus, neither Tsai nor Daniels discloses (1) a body having a through seat, (2) a tubular element that is driven through the seat and (3) means for axially and rotatably locking the tubular element in the seat with the use of two annular ridges, an annular protrusion and two flat surfaces on the annular protrusion. Applicants submit that the same are not obvious design choices and result in advantages not disclosed or even contemplated by the prior art.

In the Advisory Action, the Examiner maintained such rejections, arguing that Tsai discloses a functionally equivalent structure and the keyed elements as well as the annular protrusions and ridges would be an obvious design choice of the integrally formed tubular element and seat taught by Tsai.

In response, Applicant continues to argue that Tsai does not disclose or suggest at least the following feature recited in independent claim 29:

“means for axially and rotatably locking said tubular element in said seat that comprise two annular ridges of said tubular element provided so as to surround said tubular element, and an annular protrusion formed on said seat and suitable to engage said ridges upon forced insertion of said tubular element into said seat so as to axially horizontally retain said tubular element in said seat, and wherein said annular protrusion of said seat has two flat surfaces....”

The Applicant respectfully disagrees with the Examiner’s argument that the same is an obvious design choice for the reasons previously stated and for at least the

following additional reasons. Firstly, the Applicant knows if no authority, which holds that structure that provides the same function as that shown in the prior art (even though the claimed structure differs from the disclosed structure) is an obvious design choice and requests that the Examiner provide such authority. As discussed above, the recited structure must be a known functional or mechanical equivalent. The Examiner has failed to make such a showing.

Secondly, the Applicant submits that the Examiner's position is contrary to the constitutional mandate of promoting the progress of science, since any structure, regardless of how different or advantageous, that provides the same function as structure known in the prior art would not be afforded patent protection. Under the test set forth by the Examiner, a transistor, since it provides the same switching function as a vacuum tube known in the art, would not have been afforded protection under the U.S. patent statutes (even though the same is considered one of the greatest inventions of the 20<sup>th</sup> century).

The Applicant submits that the features recited in claim 29 and discussed above regard a specific way/construction for mutually locking a separate seat and tubular element, which one skilled in the art, even if making an obvious design choice of dividing the integral structure of Tsai in two parts (Nerwin v. Erlichman, 168 USPQ 177, 179) would not necessarily/inherently adopt.

With regard to the problems of the prior art that the claimed features (admittedly different from those disclosed in Tsai, as acknowledged by the Examiner) solve, the Applicant submits that the Examiner has clearly and improperly derived the same from the specification, where it is stated that specific material choices are imposed in modern chairs, that further impose selections also on the casters materials.

As the skilled person would objectively derive (specification page 1, lines 24-30; page 2, lines 9-10; page 4, lines 8-14) the claimed features (particularly those acknowledged as new over Tsai) of rejected claim 29 allow separate construction, efficient mutual locking and suitable mechanical strength characteristics to the body seat and to the tubular element that can be made even of mutually different materials, among which plastics, with different load bearing capacities, and physical properties, like flexibility or other, while allowing the guided vertical movement of said tubular element (with respect to the seat/support) for a self-braking device actuation..

Further still, the Applicant submits that the Examiner's argument based on *Nerwin v. Erlichman*, 168 USPQ 177, 179 is properly and objectively construed.

The alleged "obvious device choice" is based on hindsight reconstruction of the claimed invention. Actually, the Examiner has failed to make out a proper prima facie case of obviousness under 35 U.S.C. § 103. A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art.

In the specific case, Tsai provides no teaching, suggestion or incentive which would have motivated one of ordinary skill in the art to make the particular selective modification of adopting a more complicated two part construction (body seat and tubular element as recited in claim 29) instead of the simpler one -part integral solution. In this respect, see Ex parte JAMES M. GRUDEN and ROBERT B. BROOKS JR., Appeal No. 97-1147. Application 08/349,087, a copy of which is enclosed. Thus, the features recited in claim 29 could not be considered an obvious design choice over that which is disclosed in Tsai.

With regard to the rejection of claims 16-26 and 29 under 35 U.S.C. § 103(a), independent claim 29 is not rendered obvious by the cited references because neither the Tsai patent application nor the Daniels patent, whether taken alone or in combination, teach or suggest a self-orienting caster having the features discussed above and recited in independent claim 29. Accordingly, claim 29 patentably distinguishes over the prior art and is allowable. Claims 17-26 and 29, being dependent upon claim 29, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 16-26 and 29 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 27 and 28 under 35 U.S.C. § 103(a), since independent claim 29 patentably distinguishes over the prior art and is allowable, claims 27 and 28 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 27 and 28 under 35 U.S.C. § 103(a).

Lastly, new claims 30 and 31 have been added to further define the patentable invention. New claims 30 and 31 are fully supported in the original disclosure, such as at claims 17 and 20, respectively. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 30 and 31. Applicants respectfully submit that new independent claims 30 and 31 patentably distinguish over the prior art and are allowable.

As discussed in the previous response, Applicant maintains the patentability of dependent claim 20 independently of its base claim and respectfully submit that dependent claim 17 also patentably distinguishes over the prior art independently of its base claim. Claims 30 and 31 recite the features of dependent claims 17 and 20, respectively, as well as the features of base claim 29.

Claim 20 recites the *oval shape* of the through seat that accommodates the tubular element. The oval shape enables the vertical movement of the tubular element inside the seat, that actuates a self-braking device, as described at pages 6 and 7, lines 5-30 and 1-19, respectively.

Braking actuation may be achieved by virtue of the “two flat surfaces, which are suitable to engage respective flat surfaces of said tubular element in order to prevent rotation of said tubular element in said seat and to guide vertical movement of said tubular element”

Such features have been improperly neglected by the Examiner as the same are nowhere disclosed or suggest in the cited prior art.

With regard to claim 17, the prior art further does not disclose or suggest the two annular ridges surrounding the tubular element form a channel between them, and the annular protrusion formed in the seat is engageable by forcing in the channel.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,  
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza - Ste. 300  
Garden City, New York 11530  
(516) 742-4343

TS:cm

Enclosure (Ex parte JAMES M. GRUDEN and ROBERT B. BROOKS JR.)